

Attorney Docket No. P11148-US1
Customer Number 27045

REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicant has amended claims 1, 8, 10, 13-18, and 20; claims 21 through 28 were previously canceled; and claim 29 has been added. Accordingly, claims 1-20, and 29 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 102(a)

The Examiner rejected claims 1-7, 13, 14 and 17-20 under 35 U.S.C. § 102(a) as being anticipated by Ericsson (WO 99/16266). In order to expedite allowance of this application, the Applicant has amended claims to better define the intended scope of the claimed invention. The Examiner's consideration of the amended claims is respectfully requested.

For instance, amended claim 1 now states:

1. A service parameter interworking method adapted to achieve a service parameter exchange between a network using a circuit-oriented protocol and a network using a packet-oriented protocol, comprising the steps:

receiving circuit-switched service parameters from the network using the circuit-oriented protocol or packet-switched service parameters from the network using the packet-oriented protocol at an interworking node ;

checking the allowability of the service parameters;

if the service parameters are not allowable, negotiating allowable service parameters;

mapping said circuit-switched service parameters into corresponding packet-switched parameters or vice versa in said interworking node ; and

forwarding payload data between the different networks using a mapping result

wherein the service parameters are related to a service differentiation and service differentiation is achieved across a network boundary between the network using a circuit-orientated protocol and the network using a packet-orientated protocol.

In contrast, Ericsson teaches an application that sends an application flow (data stream). There is a defined Quality of Service QoS for each individual application flow

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(See Ericsson, page 8, lines 22-24). For each application flow, a determination is made as to whether a circuit switched (CS) bearer or a packet switched (PS) bearer is to be established (page 9, lines 16-18). The mapping of QoS parameters (which takes place usually in the terminal) is specified by the application (page 9, line 25 to page 10, line 1). Thus, in Ericsson, there is no teaching of a mapping between a packet switched and circuit switched bearer, but just between an IP layer coming from an application and a bearer. Therefore, there is no service differentiation across a network boundary.

The same is true in a situation described in the common access scenario where the mapping takes place in a gateway node (common access server). There is no mapping between bearers, but just between the IP-layer coming from the application and the bearer. So, there is no service differentiation across a network boundary. In other words, there is no service differentiation between bearers of different networks.

In Ericsson, a mapping takes place just between layers (as can be seen from the tables on page 24) and not between bearers. Note that at page 27, lines 4 to 14 there is no mention a parameter mapping as defined in claim 1. That reference simply refers to a translation of coding schemes, which is different that the parameter mapping of claim 1, where the parameters are related to service differentiation.

Thus, not all of the elements of claim 1 are taught by Ericsson. Consequently, the Applicant respectfully requests that the Examiner withdraw the §102 rejection.

Claims 8, 10, 13-18 and 20 have been amended to include similar limitations. Thus, it is respectfully submitted that these claims are also allowable over Ericsson for similar reasons. Consequently, allowance of claims 8, 10, 13, 14, 15, 16, 17, and 20 is also requested.

Claims 2-7 and 19 depend from the amended independent claims and recite further limitations in combination with the novel elements of these claims. Therefore, the allowance of claims 2-7 and 19 is respectfully also requested.

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3.) Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 8-12, 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ericsson in view of Blake, et al. ("An Architecture for Differentiated Services"). It is respectfully submitted that these claims have been amended to contain the limitation of: wherein the service differentiation is achieved across a network boundary between the network using a circuit-orientated protocol and the network using a packet-orientated protocol. This limitation is not found in Ericsson or Blake. Because the amended claims contain elements which are not found in the combination and the combination must contain *all* the claim elements, a §103 rejection is not proper and should be withdrawn.

Furthermore, as stated in the present specification at page 3, paragraphs 3 and 4, "it is not possible to have user determined service differentiation in case of an access from a network using a circuit-orientated protocol to a network using a packet based protocol and vice versa In contrast, if one applies the teaching of Ericsson to the this problem, one would use an additional signalling of QoS requests directly from the application, and one would determine anew, based on the additional signaling, an appropriate bearer. However, such a solution is different from the solution of claim 1. In other words, one would not arrive at the solution of claim 1 using Ericsson regardless of the combination with Blake.

In the present case, it is apparent from a reading of Ericsson and Blake that neither recognized the above identified problem. Thus, this is a classic example of a solution to a problem being obvious only after recognition of the problem by the applicant and is part of the "subject matter as a whole" language of 35 USC §103 which should always be considered in determining the obviousness of an invention under this statute.

Thus, for this independent reason, the examiner's burden of factually supporting a prima facie case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

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The Examiner rejected claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ericsson in view of Mikkonen (US 6,587,457). In order to expedite allowance of this application, the Applicant has amended claims 15-16 to better define the intended scope of the claimed invention. The Examiner's consideration of the amended claims is respectfully requested.

Specifically, the Applicant has modified these claims to include the limitation of wherein the service differentiation is achieved across a network boundary between the network using a circuit-orientated protocol and the network using a packet-orientated protocol. It is respectfully submitted that this claim limitation is not found in the combination of cited references. Because the amended claims contain elements which are not found in the combination and the combination must contain *all* the claim elements, a §103 rejection is not proper and should be withdrawn.

Furthermore, as stated in the present specification at page 3, paragraphs 3 and 4, "it is not possible to have user determined service differentiation in case of an access from a network using a circuit-orientated protocol to a network using a packet based protocol and vice versa . . . In contrast, if one applies the teaching of Ericsson to the this problem, one would use an additional signalling of QoS requests directly from the application, and one would determine anew, based on the additional signaling, an appropriate bearer. However, such a solution is different from the solution of claim 1. In other words, one would not arrive at the solution of claim 1 using Ericsson regardless of the combination with Mikkonen.

In the present case, it is apparent from a reading of Ericsson and Mikkonen that neither recognized the above identified problem. Thus, this is a classic example of a solution to a problem being obvious only after recognition of the problem by the applicant and is part of the "subject matter as a whole" language of 35 USC §103 which should always be considered in determining the obviousness of an invention under this statute.

Thus, for this independent reason, the examiner's burden of factually supporting a prima facie case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

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CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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